

REMARKS

Applicants have received the Office action dated December 31, 2007, (hereinafter "Office action") which: 1) rejects claims 6, 22-24, and 37 under 35 U.S.C. § 112, first paragraph, as allegedly not enabled by the Specification; 2) rejects 1-15, 26, 35-48, 49-56, and 57-60 under 35 U.S.C. § 101 as allegedly drawn to non-statutory subject matter; 3) rejects claims 1-10, 12-38, 40-50, and 52-60 under 35 U.S.C. § 103 as allegedly obvious over U.S. Patent Application 2006/0158354 to *Aberg et al.* (hereinafter "Aberg") in combination with knowledge of a person of ordinary skill in the art. With this Response, Applicants amend claims 1, 6, 22, 26, 34, 35, 42, and 57-60, and therefore, claims 1-60 remain pending.

I. Claim Rejections Under 35 U.S.C. § 112

Claims 6, 22-24, and 37 stand rejected under 35 U.S.C. § 112 as allegedly not enabled by the Specification. In making these rejections, the *Office action* states that the act of allocating sufficient space is a "function [that] is considered critical or essential to the practice of the invention". Applicants respectfully disagree as to whether any one limitation of the claims is "essential" to the practice of their claims and hereby disagree with the Patent Office that any particular limitation should be considered essential or critical.

a. Applicants amend claims 6 and 22-24 to overcome the rejections under 35 U.S.C. § 112

Applicants agree with the *Office action* in that the compiler performs the act of allocating the space necessary for the portable execution representation. See e.g., *Specification at paragraph [1021] (storage allocation by backend compiler); paragraph [1023] (compiler acquiring space for intermediate representation); paragraph [1033] (amount of space necessary for portable executable representation communicated to compiler)*. Thus, Applicants amend claims 6 and 22 to reflect that the portable executable representation does not perform the actual allocation.

b. Unamended claim 37 is properly enabled under 35 U.S.C. § 112

With regard to claim 37, Applicants respectfully submit that the act of "determin[ing] sufficient space for the intermediate source code representation, the source code processing command information, and the executable source code representation" is enabled at least by the Specification at paragraph [1033]. Specifically, paragraph [1033] mentions that various realizations of the claims determine the amount of space necessary and exemplary items that would determine the amount of space needed are given.

Applicants respectfully request reconsideration and submit that claims 6, 22-24, and 37 have proper enablement support under 35 U.S.C. § 112.

*II. Rejections Under 35 U.S.C. § 101***a. Applicants amend claims 1-15, 35-48 and 57-60 to overcome the 35 U.S.C. § 101 rejections**

Applicants have amended claims 1-15, 35-48 and 57-60 to clarify that the software tool is preferably located on a tangible machine-readable medium. Accordingly, Applicants respectfully submit that claims 1-15, 35-48 and 57-60 are in condition for allowance.¹

b. Applicants request clarification regarding amended claim 26

The *Office action* is unclear as to the statutory subject matter rejection of claim 26. At page two of the *Office action* there is a general statement that claim 26 is directed to non-statutory subject matter, however, there does not appear to be any analysis of such. Paragraph two, page three, of the *Office action* suggests that claim 26 is included within the analysis of claims 35-48 and 57-60, but concludes by addressing only claims 35-48 and 57-60. Adding to the uncertainty, page four of the *Office action* (under the 35 U.S.C. § 101 heading) states that claim 26 should be re-written in independent format. Applicants respectfully request clarification.

III. Claim Rejections Under 35 U.S.C. § 103

Claims 1-10, 12-38, 40-50, and 52-60 stand rejected as allegedly obvious under 35 U.S.C. § 103(a) over U.S. Patent Application 2006/0158354 to *Aberg* in combination with knowledge of a person of ordinary skill in the art. *Office action* at 4-9. Applicants respectfully traverse.

a. The *Office action* fails to establish a *prima facie* case of obviousness regarding claims 1-10, 12-15, 16-38, 40-50, and 52-60 because the proposed modification to *Aberg* would render it unsatisfactory for its Intended purpose and change its principle operation

The *Office action* specifically acknowledges that *Aberg* does not teach or suggest "includ[ing] an intermediate representation of the source code with an executable representation of the source code", as required by claim 1, but alleges that one of ordinary skill in the art would be able to modify the teachings of *Aberg* to include an executable representation along with the intermediate representation discussed by *Aberg*. *Office action* at 4-9. In order to establish a *prima facie* case of obviousness by modifying a reference there must be some suggestion or motivation to make the modification. *MPEP* § 2143. Further, if the modification required renders the cited art unsatisfactory for its intended

¹ This amendment is made to advance prosecution rather than as a concession as to the correctness of the Patent Office's policy of rejecting claims that may read on "carrier waves". Applicants are unaware of, and the *Office action* does not cite, any binding case law specifying that claims that may read on carrier waves are directed to non-statutory subject matter. Instead, the *Office action* cites to current Patent Office policy, which does not have the force and effect of law. Accordingly, Applicants reserve all rights to later interpreting these claims to cover carrier waves.

purpose or changes the principle operation of a reference, then there can be no suggestion or motivation to make the proposed modification. *MPEP § 2143.01*. Applicants respectfully traverse because the modifications proposed by the *Office action* render *Aberg* unsatisfactory for its intended purpose and change the principle operation of *Aberg*.

Aberg is directed to the generation of executable program code for a data processing system where the memory of the data processing system is to be kept "as small as possible" in order to keep the system (such as a mobile telephone or PDA) as inexpensive as possible. *Aberg* at [0001-0002] (*emphasis added*). *Aberg* keeps its system memory as small as possible by receiving a compressed intermediate representation and then generating executable program code. *Id.* at [0088] (*emphasis added*). Modifying *Aberg* to include executable program code along with an intermediate representation would increase the memory requirement, which is completely contrary to *Aberg*'s teachings. Also, one of ordinary skill in the art would not be motivated to modify *Aberg*, which generates its executable program code from an intermediate representation, to include the very executable program code that it is supposed to generate. Such a practice would significantly change the operation of *Aberg*. For at least these reasons, Applicants respectfully submit that the *Office action* fails to establish a *prima facie* case of obviousness for claim 1 as well as dependent claims 2-10 and 12-15.²

Claims 16-38, 40-50, and 52-60 contain limitations akin to claim 1, and therefore, the *Office action* fails to establish a *prima facie* case of obviousness with regard to claims 16-38, 40-50, and 52-60 for at least the same reasons as claim 1.

b. The *Office action* additionally fails to establish a *prima facie* case of obviousness regarding claim 16 because there is no explanation of how intermediate code could be indicated relative to executable code

In addition to the reasons set forth above, the *Office action* further fails to establish a *prima facie* case of obviousness with regard to claim 16 because it fails to clearly state the reasons why the claim is allegedly obvious. *MPEP § 2141* (*citing recent KSR International Co. v. Teleflex case* "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." 82 USPQ2d at 1396.). Claim 16 recites the act of "indicating the intermediate source code representation relative to the executable source code representation". The *Office action* acknowledges that the intermediate source code representation is not provided with the executable source code representation with regard to its analysis of claim 1. But the *Office action* fails to set forth

² Applicants also object to the *Office action*'s hindsight reliance on the Applicants' specification in making its *prima facie* case of obviousness, a prohibition recently reaffirmed by the Supreme Court. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1397 (2007) (*quoting Graham* and warning against reading into the prior art the claims at issue). Here the *Office action* improperly attempts to read items postulated to be present in Applicants' claims into *Aberg*.

any rationale how the intermediate source code could be indicated relative to the executable if the intermediate and executable representations are not provided with each other in *Aberg*. For at least this additional reason, the *Office action* does not establish a *prima facie* case of obviousness with regard to claim 16 as well as its dependent claims 17-26.

c. The *Office action* erroneously gave no weight to claims 6, 22-24, 37 and 40

The *Office action* gave no weight to limitations of claims 6, 22-24, 37 and 40³ that are allegedly not enabled by the Specification. Notwithstanding the merits of the enablement rejection, section 2143.03 of the MPEP is particular instructive as to the treatment of claim limitations under § 103 purposes when those limitations allegedly do not find support in the original Specification: "When evaluating claims for obviousness under 35 U.S.C. [§] 103, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed." Accordingly, Applicants respectfully request that the allegedly non-enabled features be given patentable weight.

IV. Conclusion

The Applicant thanks the Examiner for his thorough review of the application. The Applicant respectfully submits the present application, as amended, is in condition for allowance and respectfully requests the issuance of a Notice of Allowability as soon as practicable.

The Applicant believes no fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request therefor and authorization to charge Deposit Account No. 04-1415 as necessary.

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Respectfully submitted,



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³ Despite mentioning that claim 40 includes items not entitled to patentable weight due to lack of enablement, the *Office action* fails to articulate in its §112 analysis why claim 40 is allegedly not enabled. Thus, Applicants hereby request clarification.